

REMARKS

Reconsideration and allowance of this Application are respectfully requested in light of the foregoing amendments and following remarks.

Claims 1-26 are pending in the Application.

Applicants would like to thank Examiner Haq and Senior Examiner Garg for the Office Interview and hereinafter summarize the agreements reached and arguments Applicants made during the Office Interview that took place July 8, 2004 regarding overcoming the objections and rejections of the Office Action mailed March 10, 2004.

SUMMARY OF OFFICE INTERVIEW

Each of the objections alleged in the Office Action that were discussed were resolved as indicated in the following sections.

1. Claims 1-19 are rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

Claims 1 and 5

Office Action Position

The Office Action alleged that the recited limitation “...in part...” is unclear with regard to the extent the updated information is obtained from the special requisition.

Applicants' Response

Applicants discussed the ordinary dictionary meaning of “...in part...” asserting that according “in part” is defined as “in some degree” and is synonymous with “partially” and it is this ordinary meaning of “in part” that is intended in claims 1 and 5. Therefore, “in part” is to be given its ordinary meaning of between some and all since some degree can be from more than none to 100% in degree.

Applicant also asserted that a search of issued patent claims for “in part” yielded 337,089 issued patents with at least the word “part” contained in at least one claim thereof and that a refined search yielded, for example, U.S. Patent No. 6,748,287 issued June 8, 2004 to Hagen, et al. for “Adaptive Real-time Work-in-Progress Tracking, Prediction, and Optimization system for a Semiconductor Supply Chain,” in which “in part” language is used in claim limitations for an estimating step that is based *in part* on a statistical analysis (claim 6) and means for estimating is

based *in part* on a statistical analysis (claim 39). The extent of basing estimation on the statistical analysis is more than none and possibly entirely, i.e., all.

Relying on the ordinary meaning for “in part” and current use of “in part” in newly issued patents, Applicants asserted that it is quite clear to what extent the updated information is obtained from the special requisition, namely, from more than none to all the updated information is obtained from the special requisition, the amount depending on how much new information is included in the special requisition. Applicants asserted that this terminology was chosen for the claims because the ‘updated information’ does not lend itself to a unit of measure that can be quantified by typical patent terminology such as “at least one”. Accordingly, Examiner agreed that the rejection of claims 1 and 5 as indefinite for the use of “in part”, had been overcome and the rejection would be withdrawn.

Claim 1

Office Action Position

Referring again to claim 1, the Office Action alleges that it is unclear how the updated information of the limitation “updated information, wherein said updated information is obtained in part from said special requisition and added to said database for future reference” is related to the elements of the system claim.”

Applicants' Response

Applicants asserted and Examiners agreed that the database is updated by a common language generator (CLG) and rules and relationships contained in Knowledge Base. Claim 1 is presently amended to recite a common language (CLG) and CLG Knowledge Base thereby reciting how the limitation “updated information, wherein said updated information is obtained in part from said special requisition and added to said database for future reference” is related to the elements of the system claim” and thereby overcoming the objection to claim 1.

As further support, Applicants assert that the addition of the updated information obtained in part from the special requisition to the database is disclosed at page 15, line 15 to page 16, line 14. Specific attention is drawn to page 16, lines 1, 6 and 10 wherein updated information is explicitly defined. Updated information is partly or wholly obtained from the special requisition and takes in this embodiment the form of class/attribute/value relationships as well as rules. If the decision is made to add either or both relationships or rules resulting from the special requisition

then the additions become predetermined relationships and predetermined rules stored, respectively, in the database and a knowledge base. Claim 1 is directed only to storing updated information in the database, i.e., only to storing new class/attribute/value relationships in the database.

Applicants assert that the fourth limitation recites updated information obtained in part from special requisition, which special requisition is recited by the third limitation of claim 1, is added to the database of the second limitation of claim 1, i.e., the updated information is part of two structural elements of claim 1. Applicants therefore assert that updated information is related to the structural elements of claims 1, the rejection is overcome and the rejection should be withdrawn.

Claims 2-19

Office Action Position

The Office Action alleged that Claims 2-19 recite the terms ‘predetermined relationship’ and/or ‘predetermined rules’ and it is unclear to the Examiner what these terms mean or what affect they have on the structural elements of the system. The Office Action further alleges that the specification does not provide a definition for these terms, and that one of ordinary skill in the art would not be reasonably apprized of the scope of the invention. For examination purposes, the Office Action states that the Examiner will assume that these terms refer to a set of criteria for maintaining and updating a database.

Applicants and Examiners agreed that concept of a ‘predetermined relationship’ is also fundamental to the understanding of the present invention during the Office Interview and particularly as it refers to the use of the term ‘normalized’ by the Applicants in the specification. It was agreed that the ‘predetermined relationships’ recited by the claims are defined by the specification as those used to define a catalog item according to a predetermined standard or norm, thus the use of the term ‘normalized’. Applicants pointed out that ‘normalized’ in relation to catalog content is a term of art commonly used in the supply chain industry to describe catalog content that has been standardized according to some predetermined norm. Applicants further pointed out and Examiners agreed that this was the use of the term ‘normalized’ defined in the present specification and recited by the present claims. The predetermined relationships were agreed to be relationships among these standardized/normalized terms for describing an item and placing that item into a hierarchical catalog.

Thus, it was agreed that the objection to the term 'predetermined relationship' was overcome because this term was more than adequately defined throughout the specification.

As further support for the definition of 'predetermine relationship' Applicants offer that at least at the following locations in the specification this term is defined: page 3, lines 13-20 as "the catalog database as well as the special requisition are normalized using predetermined rules related to class, attribute and value relationships that are already known ... and must be followed ... to create the special requisition." and on page 8 at lines 20 et seq. as "the organizational hierarchy of items stored within one or more databases 32 and uniquely identified using a class/attribute/value relationship" as well as visualized in FIG. 5. The concept of "navigating the hierarchy of items stored within one or more databases 32 and uniquely identified using a class/attribute/value relationship and 'drilling down' through a class hierarchy until a leaf class is selected is disclosed at page 8, line 20 through page 9, line 4. Furthermore, typical types of attributes are defined at page 9, lines 12-18, the use of attributes in performing a search is defined at least at page 9, lines 5-11 and page 9, line 19 through page 10, line 6.

Applicants respectfully assert that 'predetermined relationships' are not, as alleged by the Office Action, just a set of criteria for maintaining and updating a database but is also the defining logical structure as in one class is related to another in a hierarchy and as in attributes are associated with each class and values are associated with each attribute. 'Predetermined relationships' dictate how the database is searched, how it is navigated and how it is updated/maintained and how database information is presented to a user thereof. Applicants assert that the term 'predetermined relationship' is more than adequately defined so that one of ordinary skill in the art would be reasonably apprized of the scope of the invention. That is, contrary to the allegation of the Office Action, Applicants assert that not only is the meaning of 'predetermined relationships' very clearly defined in the specification, the effect the term 'predetermined relationships' has on the structural elements of the system is also very clearly defined in the specification.

The use of terminology such as 'predetermined relationship' is becoming commonplace in issued patent claims. A search of issued patents yielded 4902 patents that include in their claim limitations at least one of a 'pre-determined relationship' or a 'predetermined relationship',

including U.S. Pat. No. 6,700,889 issued March 2, 2004 to Nun for “High Speed Apparatus and Method for Classifying a Data Packet Based on Data Values Contained in the Data Packet” and U.S. Pat. No. 6,732,088 issued May 4, 2004 to Glance for “Collaborative Searching By Query Induction.” In the former patent a ‘predetermined relationship’ is between values in fields of a packet and in the latter patent it is between lists of query results. Therefore, it is common practice for patented inventions to rely on terminology such as ‘predetermined relationship’ which can be almost any type of relationship between identified elements of a claim and in a preferred embodiment it is ‘predetermined relationships’ among class/attribute/value.

Applicants and Examiners agreed during the Office Interview that the term ‘predetermined rules’ is likewise fundamental to the understanding of the invention and is also more than adequately defined in the specification at least as follows.

As further support for the definition of ‘predetermine rules’ Applicants offer that at least at the following locations in the specification this term is defined: at page 3, line 13 et seq. it is disclosed that ‘both the catalog database as well as the special requisition are normalized using predetermined rules related to class, attribute and value relationships that are already known [predetermined]... and must be followed by the buyer to create the special requisition. Generally, these rules are stored in a knowledge base. When [free form data is received] the free form data is processed through the knowledge base to create the normalized database that a user searches. The rules used to create the normalized database are made available to the buyer to locate a specific item.’ With regard to the special requisition of an item not in a database, at page 4 line 7 et seq. the specification discloses that “the buyer and the supplier [of the special item] have proposed a revised normalization relationship to uniquely identify a desired item in accordance with the ‘predetermined rules’. The revised normalization relationship may be used to create a new rule for the knowledge base to process future items with no further human intervention.” The specification further discloses that the predetermined rules are used to convert raw or free form data into the preferred normalized format, page 15, lines 1-9. FIG. 9 even illustrates the process flow of establishing new rules in a knowledge base and entering normalized data for a new item in a database. A new rule governs how raw data is normalized for entry into a database according to the present invention, that is, how it is classified, what attributes are associated with it and what values the attributes can assume.

Thus, Applicants respectfully asserted and Examiners agreed that the disclosure adequately defines both 'predetermined rule(s)' and 'predetermined relationship(s)', provides flow charts and drawings exemplifying their use and that it would be very clear to one of ordinary skill in the art what these terms mean and what effect they have on the structural elements of the system. At a minimum, the 'predetermined relationships' determine the database hierarchy and the 'predetermined rules' determine the position and normalized content of an item in the hierarchy of a normalized database.

Thus, Applicants and Examiners agreed that clear definitions have been provided in the specification for both 'predetermined relationships' and 'predetermined rules', that there is ample and current use of the terms in issued patents, and therefore the rejections of claims 2-19 as indefinite for failing to provide a clear definition of the terms 'predetermined relationships' and/or 'predetermined rules' has been overcome and will be withdrawn.

2. Claims 17-22 and 24-26 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Office Action Position

The Office Action alleges that Applicants' invention is directed to a method for purchasing an item. However, the Office Action further alleges that the claim language does not explicitly recite any technology in the body of the claim language. The Office Action continues to allege that any technology recited in the specification but not explicitly recited in the claim language is not read into the claims, citing *In re Van Guns*, 988 F.2d 1181, 26 USPQ 2d 1057 *(Fed. Cir 1993). The Office Action acknowledges that Applicants argued in amendment C, paper number 15, that claims 17 and 20 recite the limitations 'normalized', 'database', and 'knowledge base' and that these terms render the claimed invention statutory because these terms require technology. The Examiner disagreed, "As noted above in the 112, 2nd paragraph rejection, the terms 'normalized' and knowledge base' are not defined by the specification. Therefore, it is unclear whether these terms invoke any technology. Likewise a 'database' can be a filing cabinet containing paper files and does not inherently require the use of any technology."

It was agreed that with the addition of the limitation of 'electronic' to both 'database' and

‘catalog database’ in the independent claims 1, 10, 20 and 27, the rejection of claims 17-22 and 24-26 as directed to non-patentable subject matter is overcome and the rejection would be withdrawn. The ‘electronic’ limitation is clearly supported by the specification in FIGs. 1, 8 and 9 of the specification where it is clear that these terms invoke at least computer technology in a non-trivial manner.

3. Definition of Terms: Normalized, Knowledge Base, Purchase Order, Requisition and Request for Quote

During the Office Interview, Applicants and Examiners agreed that the term ‘normalized’ is defined by the specification as

“...To make normal; cause to conform to a standard or norm...”

and is not referring to the database normalization as disclosed in the Korth reference.

Applicants further assert that the standard or norm being applied is defined throughout the specification as class/attribute/value for a standardized class hierarchy wherein members of a class are delineated in a parent child relationship [class sub-class sub-sub-class, etc.] until a leaf of a hierarchy of classes is reached. Applicants point out that at least the following parts of the specification provide support for this assertion:

PAGE LINES TEXT

FIELD OF THE INVENTION

1 5-11 The present invention relates in general to a procurement system. More specifically, the invention relates to a procurement system where a user completes a structured requisition form based predominantly on pre-existing normalized relationships to order an item not available in a catalog database. The form is used to specify the desired item and to selectively create updated normalized relationships for use in identifying the new item so that it and similar items may be placed in the catalog database when free form data is examined using the normalized relationships.

BACKGROUND OF THE INVENTION

2 18-24 Moreover, it would be highly desirable to be able to receive the information from each supplier in a consistent format [normalized format] so that review of the received information could be automated as well according to pre-determined criteria

to select the best suppliers for a possible special order. Additionally, it would be desirable to use the special expertise of both buyers and suppliers to create updated rules and item information associated with the special order. Therefore, future orders of the same item would not require the same special handling.

SUMMARY OF THE INVENTION

- 3 13- A key advantage of the present invention is that both the catalog database as well as the special requisition are normalized using predetermined rules related to class, attribute, and value relationships that are already known to the back office, and must be followed by the buyer to create the special requisitions. Generally, these rules are stored in a knowledge base. When the back office receives free form item data, the free form data is processed through the knowledge base to create the normalized database that a user searches. The rules used to create the normalized database are made available to the buyer to locate a specific item.

Thus, when making a special requisition for an item not in the database, the buyer first identifies the item using all available class, attribute, and value relationships used to create the normalized database. The remaining class, attribute and value relationship information required to uniquely identify the desired special item are then suggested by the buyer and forwarded to the back office.

The back office uses the pre-existing information identified by the buyer to pre-select potential suppliers that are already associated with the selected classes, attributes, and values and automatically forwards the special requisition to them....

One or more of the suppliers review and revise the special requisition using the same relationship approach as followed by the buyer and dictated by the pre-existing rules of the knowledge base ...Thus, at least two experts (i.e., the buyer and the supplier) have proposed a revised normalization relationship to uniquely identify a desired item in accordance with the pre-determined rules. The revised normalization relationship may be used to create a new rule for the knowledge base to process future items...

Moreover, by having a normalized item selection process, the desired item and related items may be readily added to a catalog database for future selection by other buyers ...

Yet another advantage of having a normalized approach to the special requisition process is to permit easy item comparison by a buyer. When more than one potential supplier of a desired item is located, having the item information in a normalized fashion according to class, variable [attribute] and value relationships provides easy comparison of the various items by the buyer.

BRIEF DESCRIPTION OF THE DRAWINGS

- 5 17-19 Figure 5 is an illustration of the class hierarchy of the normalized item data according to the present invention where if gases are selected, at least two sub-classes of gases are provided.

DETAILED DESCRIPTION OF PREFERRED EMBODIMENTS

- 6 14-16 ...one or more catalog databases 32 that are normalized using a common language generator ("CLG") and corresponding CLG knowledge base 30 ...

- 8 1 More typically, however, a buyer 22 takes advantage of the normalization features of system 20 by navigating the organizational hierarchy of items stored within one or more database 32 and uniquely identified using a class/attribute/value relationship ... buyer 22 then selects item classes as shown at point 90 [of FIG. 2]. Buyer 22 drills down through the various item classes that are presented in a hierarchical format. *As shown in figure 5, for example, selecting a class "gases" will present the sub-class under it. Selection of the sub-class will present the sub-sub-class and so on. The process continues as shown by decision point 92 until a leaf class (the last class in a class hierarchy) is selected.*

- 9 5 Once a leaf class is selected ... presents the attributes associated with a specific item leaf class and valid values associated with each attribute.

- 12 Typically there are three types of attributes: static, differentiating, and dynamic. SKU represents a specific item as defined by its differentiating attributes. For example, if an item is a shirt with differentiating attributes color and size, then

blue XL shirt is s SKU. Static attributes define an intrinsic property of a product and do not vary based on SKU. A differentiating attribute is an attribute that defines the uniqueness of a SKU. A dynamic attribute is an attribute that is associated with a product dynamically at buy time.

19 Once buyer 22 has selected all available attribute values then the buyer must determine if additional specifying is required as shown at decision point 96. ... at decision point 98 the use of the class/attribute/value approach permits a comparison of multiple items that meet ... search criteria ... By using the class/attribute/value approach, a consistent and specific determination of item elements is accomplished. ... provides a listing of all values available with respect to a specific attribute of interest...

10 19 If a user desires additional specifying ...A key advantage of the invention is that buyer 22 has already reduced the scope of the item requisition through the familiar normalized selection process. Thus, in most cases item classes and sub-classes have likely been determined... all the way down to a leaf class.

13 16-17 The supplier 26 may provide additional class/attribute/value information to better classify the item base on the specialized knowledge of the supplier and items within its inventory.

14 18-19 ... Every item in a catalog database is normalized in terms of class hierarchy with a final leaf class being followed by a series of attributes and attribute values....

15 3-9 The relationships are used to provide selective rule updates to the Common Language Generator knowledge base 30 and to an associated catalog database 32 using the predetermined rules of the knowledge base, as updated from time to time, to convert raw or free form data into the preferred normalized format. Thus, once a catalog database 32 is established, the catalog database is continuously fine-tuned by suppliers, buyers, and changing market conditions of which both are aware.

Therefore, based on the more than ample definition of 'normalization' as standardization with respect to class/attribute/value relationships that is provided by the specification as set forth above, Applicants here wish to explicitly assert that it was agreed to by Examiners during the Office

Interview (and as noted in the Interview Summary) that the term 'normalization' defined by the present invention is NOT any of the first, second and third or even fourth normal forms of a relational database as defined by the Korth reference, which is not analogous art to the 'normalization', i.e., standardization, disclosed and claimed by the present invention.

Knowledge Base

With regard to the term 'knowledge base', in addition to the parts of the specification cited above that jointly define 'normalization' and 'knowledge base', Applicants and Examiners agreed that a common language generator (CLG) and CLG Knowledge Base is disclosed that updates the database based on class, value, and attribute relationships according to predetermined rules. As further support, Applicants assert that the term 'knowledge base' is defined in the present specification at least at page 20 line 13 et seq. referring to FIG. 9:

“Knowledge base 30 is the glue that relates an item selection process with the items actually stored within a database 32. It [knowledge base] is formed using pre-determined rules that have been established over time that relate items to class/attribute/value characteristics or relationships. These pre-determined relationships are pulled from CLG knowledge base 30 as shown by line 222 to be compared with potential classes/attributes/values received from supplier 26 as shown by line 220. Selective update of the rules governing knowledge base 30 is shown by line 224. Line 226 represents the free form supplier item data to be normalized and then loaded into a database 32. The data is normalized using the class/attribute/value relationships that govern the common language generator and knowledge base 30.”

Thus, Applicants define a 'knowledge base' as pre-determined rules that relate items to class/attribute/value characteristics or relationships. In other words, database entries (catalog entries) are normalized (standardized) using pre-determined rules to place the item into a class hierarchy where the class hierarchy is defined by class/attribute/value relationships. Referring to FIG. 10, normalized (standard) descriptions of catalog items 230 are generated from free form or other types of product/service definitions 221 using pre-determined rules and are then placed into a hierarchical catalog 32 using previously established class/attribute/value relationships 234.

Applicants argued and Examiners agreed that the terms ‘purchase order,’ requisition’, and ‘request for quote’ are different terms that refer to different processes during procurement. A requisition, it was agreed, is a request for an item and in the case of the special requisition of the current invention is for an item not contained in a catalog so that the description can only be partially obtained from the catalog. The remainder of the description is provided by the buyer (person seeking to buy the item not in the catalog). Sources for the item may or may not be identified from the catalog as sources for items in the same class hierarchy. Prices are not included in the special requisition because they are not known. A request for a quotation is sent to a potential supplier in order to obtain a price for an item that is not contained in a catalog ad is not equivalent to a special requisition. A purchase order is a commitment to buy an item from a known supplier for an agreed upon price and is not equivalent to a special requisition.

4. During the Office Interview Applicants argued that the reference Chen et al. (U.S. Patent 6,507,856 B1) taught describing a purchase order using extensible markup language (XML) but did not teach the processing associated with a purchase order and it was agreed that the purchase order of Chen was not a special requisition.

5. During the Office Interview Applicants argued that the Dudle Reference (U.S. Pat. No 5,570,291) is Not Relevant Prior Art.

In the current Office Action and in prior Office Actions mailed January 13, 2003 and July 10, 2003 the Office Action has cited Dudle as teaching a system that allows customers to create custom orders for special items in addition to a catalog of off-the-shelf products, which can then be added to the database for processing future orders.

Applicants argued and the Examiner agreed that Dudle teaches a “Custom Product Estimating and Order Processing System” (Title) for generating estimates and orders for the manufacture of known customizations to known products, such as business forms (Abstract). The Examiner had alleges that Dudle teaches a system that allows customers to create custom orders for special items in addition to a catalog of off-the-shelf products (col. 8, lines 32-36) which can then be added to the database for processing future orders (col. 10, lines 31-34). Applicants argued that the items are

already described in the database of Dudle and their allowable customization are already described in the database of Dudle as well.

Applicants further argued that Dudle only teaches a “Custom Product Estimating and Order Processing System” in which a customer is provided with functions to specify a customization of only known products in known ways and that Dudle is not teaching a system for structuring a requisition for specifying or requesting a product not being within or found/located in a database/catalog, as recited by independent claims 1, 10, 17, 20. The customer already knows that the particular customized product that the customer wants is not going to be in the database taught by Dudle. However, the customer knows that a customizable product is known and in the database of Dudle and its customizable characteristics are known and in the database of Dudle and that Dudle's system will allow customizations that the manufacturer of the custom product can produce to meet the customer's needs.

Therefore, since every product available from the manufacturer is already in the database of Dudle and all available customizations are in the database of Dudle there is no need to add anything else, especially not various user-specific combinations of various available customization for a known product since such user-specific additions for add nothing of value to other purchasers of the customized product.

As a service to the customers of the custom product manufacturer, office supplies are also contained in the database, but, there is no way taught or suggested by Dudle for a customer to specify an office product that is not in the database. Therefore, Dudle does not teach structuring a requisition for an item but only teaches specifying already known customizations of already known items where the customizations allowed are contained in the database even if the customized product the customer wants is not. Further, Dudle does not teach adding a customer's customizations to the database but teaches placing them into a memory device for future reference by the originating customer, because such customizations are one customer's requirements for customizations and as customizations they are already included in the ranges and types of customizations taught by Dudle.

Applicants argued that one skilled in the art would know that details of customizations add nothing of value to a database of customizable products and would greatly add to the storage requirements and search time for Dudle's catalog, thereby potentially decreasing its usability and

customer satisfaction with such a database. What possible value would there be to a customer to be presented with other user's customizations of forms, for example, where the customizations include color, number of carbon copies, placement of customer name and address, number of blank lines, etc. when the customer merely wants to customize a form to his own needs? If thousands of such customizations were presented to a customer it would not be useful to the customer and would waste the customer's time during searches and browses of the database. When customizing an item the customer wants to know what features are available and how they can be customized. The customer does not want myriad details of other possible customizations because such customization are inherent in the allowable customizations taught by Dudle and which are contained in the database taught by Dudle. To support this point, Applicants argued that Dudle's customizing system is analogous to a custom clothing tailor. One person's measurements are of little use to another person seeking custom made clothing. One person's choice of fabric and trim are also of little use to another person seeking custom made clothing. So it is with forms, with the additional complication that identify theft is possible if specifications for business forms are made available to other customers.

As further support of the foregoing arguments, Applicants argued that there is no searching taught by Dudle, only specifying of known customizations of characteristics of known products. That is, Dudle teaches that users cannot specify just any characteristic but can only specify known characteristics and that users are limited to pre-established ranges, upper limits, lists of selections, for what they can specify for these known characteristics. Dudle teaches that a typical application of his teaching applies to a forms catalog where known different types of forms can be customized in only pre-established ways by a customer and the specification thus generated can be saved for that customer only in a memory device (which Dudle does not teach is the catalog). Dudle does not teach adding these customer defined specifications to the catalog. The most obvious reasons for this lack of a teaching, Applicants argued, is customer privacy and security, i.e., the data in a custom form is private to a given customer and sharing such data could lead to identify theft and trademark dilution.

There is also no sourcing taught by Dudle, i.e., there is no teaching of a process for preparing a special requisition, finding a supplier, negotiating a price with the supplier, preparing an order, transmitting an order and therefore there is no suggestion or teaching or any other motivation to combine Dudle with the other references cited by the Office Action in order to achieve the present

claimed invention. Dudle teaches a customer (or a salesman) entering specifications for a custom product in a system provided by the manufacturer of such custom products (an already known supplier of the known products) for the purpose of capturing customer specifications for the already known product and already known specifiable characteristics. This is not a special item not located within the database, as recited in claim 1, it is a known product that is located within the database and Dudle is not teaching an item specifying procedure being invoked when the desired item cannot be located within the database, as recited by claim 10. The customer or salesman in Dudle cannot, make any entry for a product that the manufacturer does not already produce, i.e., all products are known and it is only values of already known product characteristics that are specifiable in known ways by a customer or salesman.

Again, Applicants argued that the detailed specifications made by a customer, or salesman on behalf of a customer, are not added to the catalog because of privacy and security reasons but most importantly because such additional detail adds nothing of value to the catalog and only represent, unneeded details of prior orders because these products are already in the catalog and there is no need to add order details. These details are only of value to the customer who entered them or on whose behalf they were entered by a salesman. Why? Because the type of product supported by Dudle's system is only manufactured to customer specifications when such a specification is actually made. There is no inventory of products taught by Dudle because all products are built to a given customer's specifications. As a convenience for customers Dudle teaches warehousing custom products that have already been built to previous specifications, but only for the customer who ordered them in the first place. That these products have no applicability to other customers derives from their custom-built nature. Frequently, printed forms identify a source of a product or service and the original customer wants to safekeep that source's identity and not allow others to use that identity by using the original specification to build counterfeit forms.

Therefore, Applicants argued that the Dudle reference is not relevant prior art because Dudle does not teach or suggest at least a special item not being located within the database. Dudle teaches a database comprising only special items and a system for customizing these special items that are located within the database. *All items in Dudle are special items by definition.* Further, Dudle does not teach adding the specification of any item to the database but teaches saving a specification which

is not a requisition in a memory device that is not the database, for future use only by the specifying customer.

Based on Applicants arguments, both Examiners agreed that Duddle is not relevant prior art.

6. During the Office Interview Applicants Argued That Gardner Does Not Teach Adding a Non-Catalog Item From An Approved Requisition To The Catalog

During the Office Interview both Examiners alleged that since Gardner teaches that a non-catalog requisition requires a purchasing agent to locate and negotiate a price with a vendor (column 9, lines 14-18) it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to update the database of Gardner with the information from the approved non-catalog requisition. The Examiners alleged that Gardner provides the motivation for this by stating “The goal is to handle the majority of customer transactions via the catalog model, thereby capitalizing on previously negotiated contracts and eliminating non-value-added activities.” Finally, the Examiners alleged that Gardner wants to prevent a purchasing agent from re-negotiating a price with a vendor every time a requisition for a particular non-catalog item is submitted and that Gardner wants his system to capture this information and to eliminate all non-value-added activities.

Applicants argued that Gardner only teaches handling the majority of customer transactions via the catalog model and that no-where does Gardner take the opportunity to teach adding to the catalog any update information from an approved requisition for a non-catalog item even though Gardner teaches handling non-catalog items using a requisition at several distinct points in the specification. Further, Applicants argued that this lack of a teaching by Gardner is not inadvertent because not all items being requisitioned are appropriate for a catalog model incorporating pre-negotiated prices. Applicants pointed out several scenarios wherein prices cannot be pre-negotiated as in the case where the price of an item fluctuates too frequently and must be re-negotiated for each purchase. Applicants provided as another example of a non-catalog item that cannot be pre-negotiated an item whose requisitioned quantity varies based on environmental conditions so much so that quantity prices can only be negotiated each time the item is requisitioned (e.g., temperature impacting volume).

Applicants maintain their traversal of the Examiners' position, namely, that Gardner nowhere teaches updated information added to a catalog, where the updated information is obtained from an approved requisition for a non-catalog item. Further, Applicants have argued in response to past rejections based on Gardner, that an approved requisition does not represent a pre-negotiated contract for inclusion in a catalog to be applicable to all customers using that catalog. Gardner's explicit teaching is that the catalog contains only pre-approved pre-negotiated contractual prices for known items.

RESPONSE TO OBJECTIONS AND REJECTIONS

7. Claims 1-19 are rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-5 and 6-19

Overcoming the objections to claims 1-5 and 7-19 was agreed to by Examiners during the Office Interview, as discussed above.

Claim 6

Office Action Position

The Office Action alleges that since claim 1 recites the limitation "...at least one supplier..." that the scope of claim 6 is unclear to the Examiner since the metes and bounds of claim 1 can be satisfied with only one supplier while claim 6 requires more than one supplier.

Applicants' Response

It is statutorily established that Applicants may further restrict a dependent claim, 35 U.S.C. 112, 4th paragraph. Here, although independent claim 1 can be satisfied by a single supplier, claim 6 requires a plurality of suppliers.

Claim 6 recites:

"A procurement system as recited by claim 4, wherein said predetermined relationships comprise class and attribute characteristics and said at least one supplier is a plurality of suppliers, said suppliers reviewing said special requisition and said fulfillment system normalizing said updated data received from

each of said suppliers for comparison by said buyer, said buyer comparing said updated information based on identical class and attribute characteristics so as to provide a consistent basis for comparison between each special item available for purchase.” (emphasis added)

Applicants respectfully assert that since claim 6 further limits “...at least one supplier...” of claim 1 to a plurality of suppliers, claim 6 applies to a plurality of suppliers and is clear, contrary to the allegation of the Office Action, and the rejection should be withdrawn.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner et al (US Patent 5,758,327)

Office Action Position

Referring to claim 1, the Office Action admits that Gardner does not explicitly teach updated information, wherein said updated information is obtained in part from said special requisition and added to said database for future reference (as recited by claim 1). However, the Office Action alleges that since Gardner teaches that a non-catalog requisition requires a purchasing agent to locate and negotiate a price with a vendor (column 9, lines 14-18) it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to update the database of Gardner with the information from the non-catalog requisition. The Office Action further alleges that Gardner provides the motivation for this by stating “The goal is to handle the majority of customer transactions via the catalog model, thereby capitalizing on previously negotiated contracts and eliminating non-value-added activities.” Finally, the Office Action alleges that Gardner wants to prevent a purchasing agent from re-negotiating a price with a vendor every time a requisition for a particular non-catalog item is submitted and once a price has been negotiated, Gardner wants his system to capture this information and to eliminate all non-value-added activities.

Applicants' Response

Applicants respectfully assert that the rejection is moot in view of the amendment to the claims wherein claim 1 recites a common language generator (CLG) and a knowledge base. Gardner neither implicitly nor explicitly teaches either a common language generator (CLG) or a knowledge base.

9. Claims 2, 3, 8, and 9 Stand Rejected Under 35 U.S.C. 103(a) As Being Unpatentable Over Gardner et al (US Patent 5,758,327) In View of Korth et al. "Database System Concepts" And Further In View of Povilus (US Patent 5,740,425).

Applicants assert that these rejections are mooted in view of the admission by the Examiner in the Office Action that Gardner does not teach 'normalization' as recited by claim 2 and claims 3, 8, and 9 dependent therefrom and the agreement by the Examiners during the Office Interview that Korth does not teach 'normalization' as defined in the specification and claimed in the present Application.

Since, Povilus does not cure these deficiency, Claims 2, 3, 8 and 9 are allowable and the rejection should be withdrawn

10. Claim 20 is Rejected Under 35 U.S.C. §103(a) as Being Unpatentable Over Gardner et al. (U.S. Patent 5,758,327) In View of Chen et al. (U.S. Patent 6,507,856 B1)
Claim 20

Office Action Position

The Office Action admits that Gardner does not teach a structured requisition. The Office Action alleges that Chen teaches a structured requisition for a procurement process (Figure 1, column 4, lines 55-67). The Office Action alleges that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Chen into the method of Gardner and further alleges that Chen provides the motivation for doing so by teaching that typical transactions between business partners involve paperwork and delays and that maintaining a document pair (e.g. purchase order/invoice) is tedious (column 1, lines 13.32). Therefore, the Office Action continues, one of ordinary skill in the art would have been motivated to do so in order to dynamically exchange documents while eliminating delays.

Applicants' Response

Applicants respectfully traverse.

As agreed during the Office Interview and contrary to the allegation of the Office Action at the cited locations of FIG. 1 and column 4, lines 55-67, Chen does not teach a procurement system. Chen teaches using extensible markup language (XML) to describe documents for automated

exchange between business partners and, as an example only, Chen teaches an XML marked-up purchase order. Applicants argued during the Office Interview and now again assert that a purchase order is a term of art representing a commitment to purchase a known item and contains a description of the known item whereas the invention of claim 20 recites a structured requisition for an unknown item, i.e., an item not in a database. The structured requisition of claim 20 therefore contains a normalized (standardized) description of a desired item and this normalized description may only be a partial description of the classification hierarchy in which the unknown item most likely belongs. Chen's purchase order and the claimed structured requisition are not the same documents, they do not have the same purpose, and they do not contain the same information and would not be processed in the same way. For example, the purchase order of FIG. 1 of Chen contains *inter alia*

lineltem(ItemNO Quantity Unit UnitPrice ProductService* ProductDescription*...)
for a known item from a known supplier. The purchase order taught by Chen represents a commitment to purchase the at least one known item from the known supplier while a structured requisition of the present claim 20 is a normalized description of at least one unknown item sent to potential suppliers to locate a supplier for said unknown item. Therefore, combining Chen with Gardner would not remedy the admitted deficiency of Gardner, namely that Gardner does not teach a structured requisition.

Therefore, Applicants respectfully assert that one skilled in the art would not have been motivated to either use the marked up purchase order of Chen in the method of Gardner for the reasons alleged by the Office Action. That is, contrary to the allegations of the Office Action, one of ordinary skill in the art would not have been motivated to modify Gardner with the purchase order of Chen in order to dynamically exchange documents because there is no exchange of a purchase order recited by claim 20 or any purchase order recited by claim 20. The Office Action has failed to make out a *prima facie* case of obviousness with regard to claim 20 and the rejection should be withdrawn. Claim 20 is allowable and Applicants respectfully request that the rejection be withdrawn.

11. Claims 10-16 and 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Povilus (U.S. 5,740,425) in view of Dudle et al. (U.S. 5,570,291 hereinafter 'Dudle') and further in view of Official Notice.

Claim 10

Office Action Position

The Office Action alleges Dudle teaches a system that allows a customer to create custom product orders and that it would have been obvious to one having ordinary skill in the art to combine the electronic catalog of Povilus with Dudle's custom product ordering system so as to provide a customer with an item specifying procedure for an item not found in a catalog, thereby increasing customer satisfaction. The Office Action admits that Povilus fails to teach a specifying procedure, said procedure invoked when the desired item cannot be located within a catalog database, and cites Dudle as teaching a system that allows customers to create custom orders for special items in addition to a catalog of off-the-shelf products (col. 8, lines 32-36), which can then be added to the database for processing future orders (col. 10, lines 31-34). The Office Action alleges that it would have been obvious to combine Povilus' method for publishing electronic catalogs with Dudle's custom product ordering system so as to provide a customer with an item specifying procedure for an item not found in a catalog, thereby increasing customer satisfaction.

Applicants' Response

In view of the amendment to claim 10 to recite a common language generator (CLG) and a knowledge base, the rejection is mooted since neither Povilus nor Dudle teach a CLG or knowledge base and Official Notice does not cure these deficiencies.

Applicants respectfully also traverse the rejection.

Applicants reiterate their arguments presented in the responses filed on April 14, 2003 and December 10, 2003 and during the Office Interview, namely, that Dudle does not teach an item specifying procedure as recited in Claim 10 that is invoked when the desired item cannot be located in a catalog database and that Dudle only teaches customizing features of known products that are already in a catalog database, forms for example, with a pre-determined and known list of specifiable options, # plies and paper weight for example, and only within pre-determined and known ranges for each such option, valid range of #plies for each paper, weight, for example. This means that

Dudle's application never applies to products not contained therein, contrary to the response of the Office Action. There is no means taught by Dudle to specify a product that is not already contained in the catalog, or, equivalently, as recited by instant claim 10 cannot be located within the catalog. All that Dudle teaches that a user can specify in the system of Dudle is known customizations to known products that are already in the catalog, that is, Dudle teaches an all custom system in which, unless a customer warehouses a prior order or repeats a prior order which is not entered in the catalog but kept with customer data, every order is a custom order. Further, there is no generally available inventory associated with Dudle's catalog of products, every product is custom-produced with the exception of off-the-shelf office supply products and there is no way taught in Dudle to order an office supply product that is not already in the catalog or to customize an office supply product already in the catalog.

With regard to a catalog of off-the-shelf products, the only items inventoried by the system taught by Dudle are finished goods corresponding to previously specified custom orders for given customers or ready-made office supplies (col. 6, lines 54-58) and Dudle does not teach a generally available catalog that includes these customized finished goods. Dudle teaches that forms that have already been produced for a customer can be warehoused, i.e., inventoried, at a plant or distribution facility in accordance with a warehousing agreement (col. 6, lines 54-58) and Dudle does not teach that these custom products are included in a generally available catalog but only teaches that office supplies such as staplers are offered for resale in a catalogue (col. 8, lines 35-36).

Dudle teaches an item specifying procedure that is described beginning at col. 8, line 54 et seq. and results in a production order for a custom product. That the item specifying procedure of Dudle is constrained to known pre-determined products having known pre-determined options is supported in Dudle's disclosure at least at col. 11, line 52 through col 12. line 60 where Dudle explicitly teaches that Dudle's validation process prevents the sales representative from selecting features for a type of business form that cannot be priced or manufactured. The example of validation given in Dudle only ensures that all features are logically consistent, Applicants assert that Dudle explicitly teaches a system that only allows selection from a menu of known pre-determined forms or item types having only known customizable features, e.g., "The screens are designed to highlight and/or restrict the user to only those menu options that are available based on previous

inputs". Finally, Block 141 of FIG. 4 shows the sales site computer validating an item specification before it is transmitted to obtain an estimate and at col. 11, line 42-45 each plant validates every order specification it receives, just in case an inconsistent product specification slips through the sales site computer. These various validations of a specification taught by Dudle are multiple validation checkpoints in the specification process intended to assure that only those items that are already known and have already known options within known ranges are specified by the item specifying procedure. Dudle's teaching thus is intended to make it impossible to specify an item that is not known, i.e., not in the catalog.

Since Dudle does not teach an item specifying procedure to be invoked when the desired item *cannot be located* within a catalog database but only a specifying procedure for known predetermined items, the admitted deficiency of Povilus is not overcome by the teaching of Dudle and the Office Action has failed to make out a *prima facie* case of obviousness with regard to independent Claim 10 and the rejection should be withdrawn. Claim 10 is therefore allowable.

Applicants augment this prior argument with the further argument that Dudle is not relevant prior art that appears above at the beginning of these remarks and the lack in the cited references of any teaching or suggestion, explicit or implied, to motivate the combining of these references. Dudle's database is arguably a catalog but it is not a published catalog of the type published by Povilus because it is taught by Dudle as a centralized repository of item specification, estimate and customer contract data (Abstract). Therefore, there would have been no motivation to combine these references by one skilled in the art at the time the invention was made and there has to be one. The Office Action cannot use applicants invention as a roadmap for combining prior art references against Applicants. The court in *In Re Sang Su Lee*, 277 F.3d 1338, (Jan. 18, 2003) held this is impermissible hindsight and that cited references must contain a specific motivation to combine cited references and there is none here. Therefore the Office Action has failed to make out a *prima facie* case of obviousness with regard to independent Claim 10 and the rejection should be withdrawn. Claim 10 is therefore allowable.

Claims 11 and 12

Office Action Position

The Office Action alleges that Povilus substantially discloses the invention, but admits that Povilus does not disclose a procurement system where a structured requisition with a new class, attribute or value added to preexisting relationships to uniquely identify a desired item is automatically sent to suppliers who were identified by the relationships used to create the structured requisition. The Office Action alleges that Dudle discloses a system wherein a structure requisition is created by modifying an existing item specification which is stored in the database (col. 11, lines 57-63) and wherein a supplier for a structured requisition can be identified based on analysis of which supplier is equipped to most efficiently produce the custom item specifications stored in the database (col. 8, lines 14-24), and can be automatically selected by the system in the course of generating a production order (col. 15, lines 41-44 and 52-54). The Office Action further alleges that it would have been obvious to one having ordinary skill in the art to combine Povilus' method for publishing electronic catalogues with Dudle's custom product ordering system so that a customer who wishes to place a special order can do so directly from the online catalog system and save time.

Applicants' Response

In view of the amendment to claim 10 to recite a common language generator (CLG) and a knowledge base, the rejections of Claims 11 and 12, dependent therefrom, is mooted since neither Povilus nor Dudle teach a CLG or knowledge base and Official Notice does not cure these deficiencies.

Applicants respectfully also traverse the rejection.

First, Applicants disagree that Povilus substantially discloses the invention of either claims 11 or 12 because, as the Office Action admits, Povilus does not disclose a structured requisition subsystem comprising a structured requisition with a new class, attribute or value added to preexisting relationships to uniquely identify a desired item that cannot be located within said catalog database and that is automatically sent to suppliers who were identified by the relationships used to create the structure requisition and Dudle does not remedy these admitted deficiencies.

With regard to the instant claim limitations, Dudle does not teach identifying a supplier for a structured requisition based on analysis of which supplier is equipped to most efficiently produce

the custom item. At the cited location (col. 8, lines 14-24) the reference teaches that after receiving item specifications “The Job Scheduling and Tracking subsystem can schedule the completion of jobs in a manner which improves plant efficiency.” Dudle is not disclosing identification of at least one supplier, as recited by instant claim 11 (col. 8, lines 14-24), nor automatically selecting a supplier, as recited by instant claim 12 (col. 15, lines 41-44 and 52-54) at this or any other location in the cited reference. The production plant for producing a custom item by a manufacturer is selected by that manufacturer and the supplier is not being automatically selected by the mainframe computer system taught by Dudle. That is, the supplier is the manufacturer of the custom product and choosing which production facility used by a supplier is not analogous to choosing a supplier because different criteria are used for making such a choice among competing suppliers as opposed to the choice of production facilities available to a single manufacturer. In the former the choice can be optimal whereas in the latter the manufacturer is constrained to use the manufacturer's own facilities and the choice is therefore not optimal or even based on the same criteria.

Therefore, there would have been no motivation to combine these references (even to save a user thereof time, as alleged by the Office Action) by one skilled in the art at the time the invention was made, because Dudle does not cure the deficiencies of Povilus. Nor is there any suggestion, teaching or motivation disclosed in the references themselves. There has to be a motivation to combine and there is none here, see, e.g., *Ex parte Levengood*, 28 USPQ2d 1300, 1993, in which the Board of Patent Appeals and Interferences found that an Examiner cannot establish obviousness by locating references which describe various aspects of applicant's invention unless Examiner provides evidence of motivating force which would impel person skilled in the art to do what Applicants have done. The Examiner cannot use Applicants' invention as a roadmap for combining prior art references against Applicants. The court in *In Re Sang Su Lee*, 277 F.3d 1338, (Jan. 18, 2003) held this is impermissible hindsight and that cited references must contain a specific motivation to combine cited references and there is none here. Therefore the Office Action has failed to make out a *prima facie* case of obviousness with regard Claims 11-2 and the rejection should be withdrawn. Claims 11 and 12 are therefore allowable.

Claims 13-16

Office Action Position

The Office Action alleges that Povilus substantially discloses the invention, but admits that Povilus does not disclose a procurement system where a structured requisition is used to develop at least one new predetermined rule for uniquely identifying the desired item that cannot be located within said catalog database (as recited by instant claim 13), where said at least one new predetermined rule is added to said knowledge base to provide an update to said relationships (as recited by instant claim 14), where identifying information concerning the desired item is stored in said database in accordance with said relationships (as recited by instant claim 15), and where the desired item becomes a catalog item available through said selection procedure after undergoing said specifying procedure. The Office Action alleges that Dudle discloses a system with a rules selection subsystem that allows users to add rules as guidelines for creating a custom matrix for a specific customer and storing the rules in the database for future reference. The Office Action alleges that it would have been obvious to one having ordinary skill in the art to combine Povilus' method for publishing electronic catalogues with Dudle's custom product ordering system so that a manufacturer of a custom item can make its catalog customers aware that the new product exists for the purpose of increasing sales.

Applicants' Response

In view of the amendment to claim 10 to recite a common language generator (CLG) and a CLG knowledge base, the rejection of claims 13-16 are mooted since neither Povilus nor Dudle teach a CLG or CLG knowledge base and Official Notice does not cure these deficiencies. Nor are the Examiner's comments relating to the preamble of the claim appropriate in view of the foregoing amendment of claim 10.

Applicants respectfully also traverse the rejection.

First, as argued above for claims 11-12, Applicants disagree that Povilus substantially discloses the invention of any of claims 13 through 16 because, as the Office Action admits, Povilus does not disclose a structured requisition subsystem comprising a structured requisition with a new class, attribute or value added to preexisting relationships to uniquely identify a desired item that cannot be located within said catalog database and that is automatically sent to suppliers who were identified by the relationships used to create the structure requisition. Dudle does not remedy any of these admitted deficiencies of Povilus.

The Office Action has cited Dudle's disclosure (col. 18, lines 4-15) of a rules selection subsystem for a pricing matrix for which the Office Action has not provided an interpretation that a pricing matrix is a teaching of the limitations of claim 13-16 wherein the structured requisition is used to develop at least one rule that uniquely identifies a desired item that cannot be located within the catalog, is added to the knowledge base to provide an update to relationships which uniquely identify the desired item, where information concerning the desired item is stored in the catalog according to the updated relationships and where the desired item becomes available to users of the catalog. By no stretch of the teaching of Dudle of rules for selecting data of a price matrix can Dudle's teaching be said to disclose rules for uniquely identifying anything, let alone an item in the database. Dudle does not teach using rules in this manner.

Thus, there is no motivation, suggestion or teaching in the cited references for combination thereof for any reason let alone for developing at least one new predetermined rule for uniquely identifying the desired item that cannot be located within the catalog, for adding the rule to said knowledge base to update said relationships, to store identifying information concerning the desired item in the catalog in accordance with said updated relationship, and thereby making the desired item available through the catalog thereafter. Further, there would have been no motivation to combine these references (even to make catalog customers aware that the new product exists for the purpose of increasing sales, as alleged by the Office Action) by one skilled in the art at the time the invention was made, because Dudle doesn't teach using rules for identification of an item. There has to be such motivation or suggestion or teaching, and there is none here. The Office Action cannot use applicants invention as a roadmap for combining prior art references against Applicants. The court in *In Re Sang Su Lee*, 277 F.3d 1338, (Jan. 18, 2003) held this is impermissible hindsight and that cited references must contain a specific motivation to combine cited references and there is none here. Therefore the Office Action has failed to make out a *prima facie* case of obviousness with regard to claims 13-16 and the rejection should be withdrawn. Claims 13-16 are therefore allowable.

Claim 20

Office Action Position

The Office Action alleges, in part, that Dudle teaches transmitting the custom order to a potential supplier (col., line 19 - col. 4, line 6).

Applicants' Response

In view of the amendment to claim 20 to recite a common language generator (CLG) and a CLG knowledge base, the rejection is mooted since neither Povilus nor Dudle teach a CLG or CLG knowledge base and Official Notice does not cure these deficiencies.

Applicants respectfully also traverse the rejection.

Contrary to the allegation of the Office Action, neither at the cited location in the Dudle reference and nor anywhere else in the reference does Dudle teach the recited limitation of claim 20 of “transmitting said structured requisition to at least one potential supplier”. Further, neither Povilus nor Dudle teaches the recited limitation of claim 20 of locating a desired supplier for said item, where said item is not in the database. There is no explicit or implied suggestion or teaching to serve as motivation in either reference cited to combine the references to achieve the invention of instant claim 20 because the two foregoing limitations are not taught by either reference. There has to be motivation or a suggestion or a teaching to combine references and there is none here, see *Levengood, supra*. Further, the Office Action cannot use applicants invention as a roadmap for combining prior art references against Applicants. The court in *In Re Sang Su Lee, supra* held this is impermissible hindsight and that cited references must contain a specific motivation to combine cited references and there is none here. Therefore the Office Action has failed to make out a *prima facie* case of obviousness with regard to claim 20 and the rejection should be withdrawn. Claim 20 is therefore allowable.

Claims 21-26

Referring now to claims 21-26, claims 21-26 are dependent from allowable claim 20, and are allowable for at least this reason and their rejections should be withdraw as well.

12. Claims 17-19 Stand Rejected Under 35 U.S.C. §103(a) As Being Unpatentable Over Povilus (US Patent 5,740,425) in view of Dudle et al. (U.S. Patent 5,570,291) And further In view of Official Notice.

Office Action Position

The Office Action admits that Povilus does not teach processing a request for a special item not located within the catalog database using the predetermined relationships, but alleges that Dudle teaches a processing a custom order for a item that is not located in the electronic database, and the

Office Action further alleges that the custom ordering software used by Dudle requires the application of standard rules and procedures that would apply to any custom product being designed. Therefore, the Office Action alleges there would have been motivation to combine Povilus with Dudle so that a custom item can be rapidly added to a catalog using predetermined schema, thereby enabling catalog customers to access a new product for the purpose of increasing sales by selling to a wider market. The Office Action alleges that even though Dudle does not explicitly teach that these implied standard rules and procedures correspond to predetermined relationships in a database, Official Notice is taken that the use of XML for interchange of information and to create domain-specific templates within an industry is old and well known. Therefore, the Office Action alleges that it would have been obvious to one of ordinary skill in the art to use XML as part of the implied standard rules and procedures of Dudle in order to use a simple, robust, and human-readable method for describing any content.

Applicants' Response

Instant claim 17 recites in pertinent part a limitation of “determining rules to convert free form information associated with said catalog items into said normalized database.” Even assuming, *arguendo*, that Dudle’s teaching implies the application of standard rules and procedures that would apply to any custom form being designed, as alleged by the Office Action, instant claim 17 recites knowledge based rules and Dudle does not teach any such rules for conversion of free form information into normalized database, i.e., catalog, entries, as recited by claim 17. Dudle teaches saving customer specifications selected from known customizations for known products wherein these specifications are saved to a memory device and not a database.

Finally, given that there are no rules for converting free form information to catalog entries taught by Dudle there would be no motivation to use XML for rules that are not taught by Dudle. Further, Dudle does not teach or suggest exchanging the content of his database/catalog with any other system. Therefore, one of ordinary skill in the art would not have been motivated to use XML to describe Dudle’s database content because there would be no reason to so describe it.

There has to be an implied or explicit suggestion or a teaching to serve as a motivation to combine references and there is none here, see *Ex parte Levengood, supra*. The Office Action cannot use applicants invention as a roadmap for combining prior art references against Applicants. The

court in *In Re Sang Su Lee*, *supra* held this is impermissible hindsight and that cited references must contain a specific motivation to combine cited references and there is none here.

Therefore the Office Action has failed to make out a *prima facie* case of obviousness with regard to claim 17 and the rejection should be withdrawn. Claim 17 are therefore allowable. Claims 18-19 are dependent from allowable claim 17, and are allowable for at least this reason and their rejections should be withdrawn as well.

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Povilus (U.S. Patent 5,740,425) in view of Gardner et al (U.S. Patent 5,758,327).

Office Action Position

The Office Action admits that Povilus does not teach an item specifying procedure that is invoked when the desired item can't be located by said item selection procedure with the catalog database. The Office Action alleges that Gardner teaches a procurement system for purchasing a desired item (Abstract; col. 1, lines 5-8; col. 4, lines 45-66), that Gardner teaches an item specifying procedure within the catalog database (col. 9, lines 14-18) and therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Gardner into the system of Povilus since Povilus states that Povilus' catalog is intended to be used by a variety of individuals including people who place an order for a product. (col. 1, lines 38-67).

Applicant's Response

Applicants respectfully traverse.

At the cited location in the Povilus reference, Povilus' is discussing how catalog content is structured to address particular audiences such as design, construction or maintenance positions and the need for publishing electronic and printed product information in multiple renditions from a single product database that present product information in the level of detail intended for each and/or all individuals involved in the design, construction, and maintenance process. The cited location in the cited reference is discussing level of detail and not item specification and therefore cannot serve as motivation of something that is not being discussed. The cited location in Povilus provides no teaching or suggestion that would motivate one skilled in the art to combine Povilus' catalog with any item specifying procedure let alone the teaching of Gardner because item specifying is not even being

discussed but only level of detail of catalog content is being discussed and then only the need for varying the level of detail as is appropriate for the audience (buyer type).

There has to be some motivation to combine references and there is none here. The variety of users cited by the Povilus' reference at col. 1, lines 38-67 is intended to indicate that the level of detail provided by a description of catalog items may differ for different types of buyer. If Gardner teaches an item specifying procedure that is invoked when the desired item can't be located (column 9, lines 14-18) then it does not matter what level of detail is provided since it cannot be found. Further, even if catalog item descriptions are particularized to different buyers, there still does not provide any motivation in the cited references to combine them.

Therefore, the Office Action has failed to make out a *prima facie* case of obviousness and claim 10 is allowable. The rejection of claim 10 should be withdrawn.

Applicants note that since claims 11-16 are dependent from allowable claim 10, claims 11-16 are allowable for at least this reason and any rejections thereof should be withdrawn.

14. Claims 4 and 5 Stand Rejected Under 35 U.S.C. §103(a) As Being Unpatentable Over Gardner et al. (U.S. Patent 5,758,327) in view of Povilus (U.S. Patent 5,740,425) And Further In View of Dudle et al.

Office Action Position

The Office Action alleges that Gardner and Povilus substantially disclose the invention. The Office Action admits that neither Gardner nor Povilus specifically teach a special requisition including a proposed modification to a predetermined relationship, a supplier reviewing the special requisition, basing the new predetermined rule on updated information with a special requisition, or a buyer comparing the updated information as a basis for comparison between each special item available for purchase. The Office Action alleges that Dudle teaches a product estimating and order processing system in which custom item specifications are stored for use as a template for designing further custom business forms and which allows a supplier to review a custom product order to make changes as needed (col. 14, lines 47-67). The Office Action alleges that it would have been obvious to one having ordinary skill in the art to combine Gardner and Povilus' system for updating an electronic catalog to reflect a new product offering with Dudle's custom order processing system in order to allow a manufacturer to quickly add new item produced for a special requisition to its online

catalog in order to sell to the general public instead of selling only to the buyer who requested the product initially, thereby generating increased revenue into the future.

Applicants' Response

Applicants respectfully traverse.

With regard to claim 4, at the cited location in the Dudle reference (col. 14, lines 47-67) the alleged supplier is reviewing the estimated cost of producing a customized product. Dudle does not teach a supplier reviewing the special requisition and proposing modification to at least one of said predetermined relationships, as recited by claim 4. Dudle does not anywhere discuss describing catalog content, i.e., relationships, or proposing modification to at least one of said predetermined relationships. Therefore, there is no suggestion or teaching that would serve as a motivation to combine the cited Dudle and Povilus references to reject claim 4 as obvious thereover. The Office Action has failed to make out a *prima facie* case of obviousness with respect to claim 4, claim 4 is allowable and the rejection should be withdrawn.

With regard to claim 5, as discussed in the Summary of the Office Interview, the Dudle reference is inapt for a special requisition because Dudle **is not specifying a new product offering but only a customization of a known product** which specification would not be added to a catalog because, as repeatedly discussed above, (1) it is likely to be a security issue if such a customization includes customer identification, as it likely would for custom forms (name, address, trademark, color, plies, stock type, etc.), (2) does not add anything of value to the catalog since the product is already contained in the catalog along with its available/allowable customizations and specific values of customizations have no value to other customers who already have this information in the available/allowable values for customizations, and (3) adding such detailed customizations wastes time and space on a recurring basis and reduces the usability and efficiency of the catalog to which it is added, and most importantly (4) Dudle does not teach adding a description of the item to the catalog because such a description is already there for future use by any customer, and (5) Dudle does not teach adding such customizations to the catalog but only teaches saving them in a memory device for future use by the customer for whom they were developed in the first place. One skilled in the art would not be motivated to add customizations for known products to a catalog because these additions would add nothing of value to the catalog because a description of the item is already contained in the

catalog and customizations by each customer for a particular product would only clutter up the database with unnecessary, useless data thereby increasing search time and storage costs to say nothing of the processing cost of adding such copious amounts of useless information to the catalog. Therefore, contrary to the allegation of the Office Action that it would have been obvious to one having ordinary skill in the art to combine Gardner and Povilus' system for updating an electronic catalog to reflect a new product offering (it's not a new product it's just customizations of already included products) with Dudle's custom order processing system in order to allow a manufacturer to quickly add a new item (it's not a new item) produced for a special requisition to its online catalog in order to sell to the general public instead of selling only to the buyer who requested the product initially, thereby generating increased revenue into the future, one skilled in the art would not have been so motivated because nothing of value would be added by including this minutiae. Further, one skilled in the art would also not be motivated to include customizations because to do so would be to include redundant information, over and over again, assuming that the already included product information would have to be repeated every time a customization is included. The products are already in the catalog and the customizable features are in the catalog and so are the allowable values or ranges for customizations. Time, space, efficiency, etc. considerations all militate against one skilled in the art being motivated to add this redundant information. In addition, a lone customization does not provide a view of the range of customizations available, it is very limiting and customers would not be well served by a system that provides them and this is a further reason one skilled in the art would not be so motivated.

Thus, there is no teaching or suggestion and therefore no motivation in the cited references to combine them to achieve the current invention and furthermore, as just discussed, one skilled in the art would not be motivated to combine them because their combination would detract from the catalog's usefulness by adding useless detailed customizations of known products rather than adding a new item. The buyers already have access to the product and its available customizations. Therefore, Applicants assert there is no teaching or suggestion and therefore no motivation to combine the references either impliedly or explicitly in the references themselves and one skilled in the art would not be motivated for any reason to combine the references, as discussed above, and the Office

Action has failed to make out a *prima facie* case of obviousness with respect to claim 5, claim 5 is allowable, and the rejection should be withdrawn.

15. Claim 6 Stands Rejected under 35 U.S.C. §103(a) as being unpatentable over Gardner et al (U.S. Patent 5,758,327) in view of Povilus (U.S. Patent 5,740,425) and further in view of Dudle et al., and Conklin et al. (U.S. 6,338,050).

Office Action Position

The Office action admits that Gardner, Povilus, and Dudle do not teach a system where a plurality of suppliers review a special requisition and forward updated information for comparison by the buyer. The Office Action alleges that Conklin et al. discloses a multivariate negotiations engine which allows a buyer to submit a Request for Proposal or Request for Quote to multiple sellers (col. 20, lines 23-20; col. 6, lines 19-20 and 25-32). Further, the Office Action alleges that it would have been obvious to one having ordinary skill in the art to combine Conklin et al.'s multivariate negotiations engine with Povilus' method for updating an electronic catalog and Dudle et al.'s custom order processing system in order to allow multiple manufacturers to respond to a special requisition placed by a buyer and compete with each other on an equal footing in order to potentially increase each manufacturer's sales.

Applicants' Response

Claim 6 recites normalizing the updated data received from a plurality of suppliers so that a buyer can compare the updated information based on identical class and attribute characteristics. This is not a multivariate negotiations engine but a normalization of data received from a plurality of suppliers that makes the description of items consistent thereby enabling their comparison by a buyer. Conklin does not teach normalizing descriptions of items from multiple sellers so that a buyer is comparing them based on identical class and attribute characteristics, as recited by claim 6. The Conklin reference is not relevant prior art for the subject matter of claim 6 and because it is not relevant prior art the Office Action has failed to make out a *prima facie* case of obviousness with respect to claim 6, claim 6 is allowable and the rejection should be withdrawn.

16. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Gardner et al (U.S. Patent 5,758,327) in view of Povilus (U.S. Patent 5,740,425) and further in view Conklin et al. (U.S. 6,338,050).

Office Action Position

The Office Action alleges that Gardner and Povilus teach all the limitations of claim 2 and that Povilus teaches a system wherein suppliers are identified with specific predetermined relationships (col. 17, lines 49-54). The Office Action admits that Gardner and Povilus do not teach a fulfillment organization selecting a plurality of suppliers to receive and review a special requisition. The Office Action alleges that Conklin discloses a negotiations system which comprises a sponsor who creates and administers a negotiation engine for participation between buyers and sellers (col. 14, lines 1-19), including setting rules for supplier participation to determine that a supplier can fulfill a buyer's requirements (co. 28, lines 46-51). The Office Action then alleges that it would have been obvious to one having ordinary skill in the art to combine the teachings of Conklin with the system of Gardner and Povilus in order to create a commercial community with a set of rules administered impartially for buyers and sellers by an administrator.

Applicants' Response

Applicants respectfully traverse.

First, as discussed above with reference to claim 2, Gardner and Povilus, neither alone nor in combination, teach all the limitations of claim 2 and Conklin does not remedy the previously identified deficiencies of Gardner and Povilus. Therefore, for at least this reason, the Office Action and failed to make out a *prima facie* case of obviousness, claim 7 is allowable, and the rejection should be withdrawn.

Second, Conklin is not relevant prior art with respect to claim 7. The cited location in the Conklin reference, col. 28, lines 46-51, teaches seller performance rules that govern whether or not a seller can participate in a commercial community and these rules taught by Conklin are not equivalent to the predetermined relationships for standardizing catalog descriptions of items that is recited by claim 7. The predetermined relationships of claim 7 are first recited in claim 2, from which claim 7 depends, as being part of a knowledge base used to normalize catalog item information with respect to the predetermined relationships. Supplier is a part of the catalog information for an item. Further, the predetermined rules recited by claim 7 are rules for preparing the special requisition and are not equivalent to the supplier performance rules taught by Conklin at col. 28, lines 46-51. The at least one supplier recited by claim 2, from which claim 7 depends, is a supplier of catalog information

for products that the supplier is capable of supplying. There is no correspondence or equivalence between the predetermined rules and relationships recited by claim 7 and the performance rules taught by Conklin. Therefore, Conklin does not cure the admitted deficiency of Gardner and Povilus with respect to a fulfillment system selecting a plurality of suppliers to receive and review a special requisition. The suppliers selected by claim 7 are already participants in the procurement system and are identified in the catalog (associated with existing classes, attributes and values of the catalog) whereas Conklin teaches creating a commercial community in which sellers must comply with a set of performance rules (col. 28, lines 46-51) in order to participate in the community and while the Office Action alleges these rules include determining that a supplier can fulfill a buyer's requirements, the cited location in the cited reference does not so teach. Therefore, the Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 7 because none of the Povilus, Gardner, and Conklin references, either alone or in combination, teaches the fulfillment system recited by claim 7. Claim 7 is therefore allowable and the rejection should be withdrawn.

17. Examiner's Response to Arguments of Prior Office Action

The Office Action allegation that Applicant's assertion the Gardner teaches away from adding information for non-catalog items since Gardner allegedly stores information only on pre-approved items and not on approved non-catalog items is completely irrelevant since there is nothing in the claim language which recites that the special item is either a pre-approved item or an approved item, is irrelevant since the amended claims recite an electronic database and a knowledge base which Gardner clearly lacks. Thus using the common language generator and knowledge base to update the database for future use is not within the contest of the teachings of Gardner.

The Examiner alleges that "Clearly, one of ordinary skill in the art would realize that Gardner's invention eliminates these non-value-added activities by automating the purchase order" referring to having a purchasing agent repeatedly contact and negotiate with a supplier every time an order for an item was placed. Gardner teaches non-catalog items being ordered and does so over and over again and yet Gardner, one ordinarily skilled in the art does not take any of the many opportunities to teach capturing the information for the non-catalog order and updating the catalog and not in the manner

recited by the claims. Therefore, contrary to the allegation of the Office Action Applicants assert that even if one ordinarily skilled in the art would assume that Gardner wanted to capture this information concerning non-catalog items, Gardner does not provide a teaching of the limitations of the presently claimed invention.

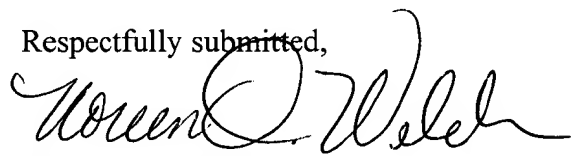
The Examiner defines repeatedly contacting and negotiating with a supplier every time an order for an item was placed as a “non-value-added activity”. Gardner does not anywhere define this as a “non-value-added activity”. If the price of an item is highly volatile it might be desirable to negotiate every time and thus an item might be omitted on purpose from a catalog. If an item is scarce and thus there is no standard price, it might be omitted on purpose from a catalog. If an quantity discounts are structured by the seller for each purchase, it might be omitted on purpose from a catalog. There are many reasons why an item does not appear in a catalog and the Examiner cannot impute a motive to Gardner when it is quite clear that Gardner does not teach including updated information obtained from a special order in the catalog of his invention and certainly does not provide a teaching of the claimed system or method.

Conclusion

In view of the foregoing remarks, all stated rejections of the Office Action have been overcome and this Application is in condition for allowance. Early notice to that effect is earnestly solicited.

If any issues remain which may be best resolved through a telephone communication, the Office Action is requested to kindly telephone the undersigned at the local, Washington D.C. telephone number listed below.

Respectfully submitted,



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Date: December 10, 2003

NOW/att

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